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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/393,168    09/10/99    ISHIKAWA    T    724-P10-2589

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HM12/0529

EXAMINER

NGUYEN, H

ART UNIT

PAPER NUMBER

1617

DATE MAILED:

05/29/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

**Office Action Summary**

Application No.

09/393,168

Applicant(s)

ISHIKAWA ET AL.

Examiner

Helen Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This application is claim to priority to a foreign application number JP10-258981, filed September 11, 1998, is acknowledged.

Applicants' response to the elections of species filed on May 8, 2001, paper no. 4, is acknowledged. The election of water-soluble dietary fiber (specie B) is maintained. Elections of species over the dispersion stabilizer (specie C) and the fat and oil material or oil soluble material (specie E) are withdrawn in view of a finding of art over these species.

Claims 1-20 are presented for examination with elected specie B drawn to water-soluble dietary fiber.

### Specification objection

The disclosure is objected to because of the following informalities:

In the specification on page 12, Table 2, the term "gymnema" is typographical error.

Appropriate correction is required.

### Claim rejection

The following is a quotation of the **first paragraph of 35 U.S.C. 112**:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as

containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly

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connected, to make and/or use the invention. Applicants claim a dietary fiber, however nowhere in the specification is disclosed any example of a specific dietary fiber.

The following is a quotation of the **second paragraph of 35 U.S.C. 112**:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

*most  
App's only  
admit  
the CS  
by indicating  
"other than  
the dietary  
fiber"  
is it clear?  
clear*

In claims 17-20, Applicants claim a dietary fiber and material of limited oil-solubility. However on page 4, lines 15-16, Applicants disclose that dietary fiber is a material of limited oil-solubility. Therefore claims 17-20 collapse to dietary fiber, contradicting the stated 2 ingredients in the claims.

The following is a quotation of the appropriate paragraphs of **35 U.S.C. 102** that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Miskel et al. (US Patent No. 3,851,051).

Miskel et al., see Example 1 column 6, teach a soft capsule comprising a water-soluble dietary fiber (citrus pectin) and a material of limited-oil solubility (diphenhydramine). No dispersion stabilizer and fat and oil material or oil-soluble material is present. Thus, Example 1 anticipates claims 1-12 and 17.

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Further Miskel et al., see Example 50, teach a soft capsule comprising a water-soluble dietary fiber (apple pectin), a material of limited oil-solubility (glycerin) and a fat and oil material or oil-soluble material (vitamin E). Thus, Example 50 anticipates claims 13-16, 18 and 20.

Lastly, Miskel et al., see Example 43, teach a soft capsule comprising a water-soluble dietary fiber (citrus pectin) and a material of limited oil-solubility (sodium saccharin). No dispersion stabilizer and fat and oil material or oil-soluble material is present. Thus, Example 43 anticipates claim 19.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen Nguyen whose telephone number is (703) 605-1198. The examiner can normally be reached on M-F (9:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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Helen Nguyen  
Patent Examiner

May 25, 2001

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PATENT EXAMINER  
GROUP 150